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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,489	11/14/2003	Hau H. Duong	067456-5012-US02	1026
67374 7590 09/14/2010 MORGAN, LEWIS & BOCKIUS, LLP (SF) ONE MARKET SPEAR STREET TOWER SAN FRANCISCO, CA 94105				
EXAMINER LU, FRANK WEI MIN				
ART UNIT 1634		PAPER NUMBER		
MAIL DATE 09/14/2010		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/714,489

Applicant(s)

DUONG ET AL.

Examiner

FRANK W. LU

Art Unit

1634

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-28 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 13, 17, 18 and 20-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

CONTINUED EXAMINATION UNDER 37 CFR 1.114 AFTER FINAL REJECTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission of RCE and the amendment filed on May 27, 2010 have been entered. The claims pending in this application are claims 12-28 wherein claims 14-16 and 19 have been withdrawn due to species election mailed on May 27, 2007. Rejection and/or objection not reiterated from the previous office action are hereby withdrawn in view of applicant's amendment filed on May 27, 2010. Claims 12, 13, 17, 18, and 20-28 will be examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Enablement

Claims 12, 13, 17, 18, and 20-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Factors to be considered in determining whether a disclosure meets the enablement requirement of 35 USC 112, first paragraph, have been described by the court in *In re Wands*, 8 USPQ2d 1400 (CA FC 1988). *Wands* states at page 1404,

“Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized by the board in *Ex parte Forman*. They include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.”

The nature of the invention

The claims are drawn to a method for detecting the presence of a target analyte. The invention is a class of invention which the CAFC has characterized as “the unpredictable arts such as chemistry and biology.” *Mycogen Plant Sci., Inc. v. Monsanto Co.*, 243 F.3d 1316, 1330 (Fed. Cir. 2001).

The Breadth of The Claims

Claims 12, 13, 17, 18, and 20-28 encompass a method for detecting the presence of a target analyte by analyzing the output waveform using peak recognition.

Working Examples

The specification provides no working example for the methods recited in claims 12, 13, 17, 18, and 20-28.

The Amount of Direction or Guidance Provided and The State of The Prior Art

The specification does not provide a guidance to show that the methods recited in claims 12, 13, 17, 18, and 20-28 can be performed. Furthermore, there is no experimental condition and/or experimental data in the specification to support the claimed invention. During the process of the prior art search, the examiner has not found any prior art which is related to the methods recited in claims 12, 13, 17, 18, and 20-28..

Level of Skill in The Art, The Unpredictability of The Art, and The Quantity of Experimentation Necessary

While the relative skill in the art is very high (the Ph.D. degree with laboratory experience), there is no predictability whether the methods recited in claims 12, 13, 17, 18, and 20-28 can be performed.

First, since the assay complex comprises a target analyte, a capture analyte and an electron transfer moiety that is response to an input waveform and claim 25 does not indicate that said ETM only associates with said target analyte and does not associate with said capture analyte, it is possible that an output waveform generated from an input waveform is due to the presence of said capture binding ligand in the assay complex. Thus it is unclear how an output waveform generated from an input waveform can indicate the presence of said target analyte and cannot indicate the presence of said capture binding ligand such that the methods recited in claims 12, 13, 17, 18, and 20-28 cannot be performed. Furthermore, since claim 26 does not indicate that a plurality of different ETMs only associates with a plurality of different target analytes and does not associate with said capture analyte, it is possible that an output waveform generated from an input waveform is due to the presence of said capture binding ligand in the

assay complex. Thus it is unclear how detecting said plurality of different ETMS can be used as a measure of the presence of said plurality of different target analytes and cannot used as a measure of the presence of said capture binding ligand in claim 25 such that the methods recited in claims 12, 13, 17, 18, and 20-28 cannot be performed.

Second, since the phrase “analyzing the output waveform using peak recognition” in claim 25 is directed to a method, it is unclear how a method can served as an indication of the presence of said target analyte.

In view of above discussions, the skilled artisan will have no way to predict the experimental results. Accordingly, it is concluded that undue experimentation is required to make the invention as it is claimed. The undue experimentation at least includes to test whether the method recited in claims 12, 13, 17, 18, and 20-28 can be performed.

Conclusion

In the instant case, as discussed above, the level of unpredictability in the art is high, the specification provides one with no guidance that leads one to claimed methods. One of skill in the art cannot readily anticipate the effect of a change within the subject matter to which the claimed invention pertains. Thus given the broad claims in an art whose nature is identified as unpredictable, the unpredictability of that art, the large quantity of research required to define these unpredictable variables, the lack of guidance provided in the specification, the absence of any working examples related to claimed invention and the no teaching in the prior art balanced only against the high skill level in the art, it is the position of the examiner that it would require undue experimentation for one of skill in the art to perform the method of the claim as broadly written.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 12, 13, 17, 18, and 20-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 25 is rejected as vague and indefinite because the phrase “analyzing the output waveform using peak recognition as an indication of the presence of said target analyte” does not make sense. Since the phrase “analyzing the output waveform using peak recognition” is directed to a method, it is unclear why a method can serve as an indication of the presence of said target analyte. Please clarify.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 12, 13, 17, 18, and 20-28 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,740,518 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examined claims in this instant application are either anticipated by, or would have been obvious over, the reference claims. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). Although claims 12, 13, 17, 18, and 20-28 in this instant application are not identical to claims 1-27 of U.S. Patent No. 6,740,518 B1, the contents of U.S. Patent No. 6,740,518 B1 teach that electronic detection is by chronocoulometry (see column 85, last paragraph bridging to column 86, first paragraph), the output current is fed into the lock-in amplifier (see column 103), ETM can be transition metal complexes comprising a ferrocene (see column 14, 29-48 and column 38, lines 40-43), and the AC frequency ranges from about 0.01 Hz to about 100 MHz, with from about 10 Hz to about 10 MHz being preferred, and from about 100 Hz to about 20 MHz being especially preferred (see column 79, lines 25-41), and “at least one electrode” in claim 1 of U.S. Patent No. 6,740,518 B1 means one or more electrodes, claims 1-27 of U.S. Patent No. 6,740,518 B1 are directed to the same subject matter and fall entirely within the scope of claims 12, 13, 17, 18, and 20-26 in this

instant application. In other words, claims 12, 13, 17, 18, and 20-28 in this instant application are anticipated by claims 1-27 of U.S. Patent No. 6,740,518 B1.

Response to Arguments

In page 7, fourth paragraph of applicant's remarks, applicant argues that "[A]pplicants respectfully request that this rejection be held in abeyance until patentable subject matter has been found notwithstanding any double patenting rejection".

This argument has been fully considered but it is not persuasive toward the withdrawal of the rejection because applicant has not filed a terminal disclaimer.

Conclusion

9. No claim is allowed.
10. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Nguyen, can be reached on (571)272-0731.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frank W Lu /
Primary Examiner, Art Unit 1634
September 13, 2010